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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/594,284	06/15/2000	Yoji Kawamoto	SONY-T0718	9179
26263 7590 08/22/2007 SONNENSCHN NATH & ROSENTHAL LLP P.O. BOX 061080 WACKER DRIVE STATION, SEARS TOWER CHICAGO, IL 60606-1080			EXAMINER MANIWANG, JOSEPH R	
			ART UNIT 2144	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/594,284	<b>Applicant(s)</b> KAWAMOTO ET AL.	
	<b>Examiner</b> Joseph R. Maniwang	<b>Art Unit</b> 2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 June 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13,14,18,21,23,25 and 27-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13,14,18,21,23,25 and 27-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/27/07 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. Claims 13, 14, 18, 21, 23, 25, 27, 34-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Dedrick (U.S. Pat. No. 5,717,923) in view of Lee et al. (U.S. Pat. No. 6,751,459), hereinafter referred to as Lee.
3. Regarding claim 13, Dedrick teaches about a user information processing system comprising (Fig 1) (Col 2, lines 60-65): a terminal unit "client system-personal computer" for use by a user adapted for accumulating use of said terminal unit by said user and the profile information of said user "client activities monitoring", wherein said profile information includes identifying Information about said terminal unit (Col 5, lines 20-40) (Col 5, lines 50-60); (The session manager has to know the identity of the terminal (IP source address) in order to setup a session between the terminal and server). said server "metering server" server accessible by said terminal unit adapted for producing

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said profile information; (Col 9, lines 25-35); and storing means "personal profile database 27" detachably provided in said terminal unit for storing said profile information so that when the user uses a terminal unit, the terminal unit accesses the user profile information from the storing means to obtain information peculiar to the particular user using the terminal (Col 5, lines 50-65) (Col 6, lines 5-15); but does explicitly teach that the user and profile information is collected base on the terminal use information. Dedrick teaches about the possibility of using different client systems (Terminal unit) (Col 3, lines 1-10) in which each transaction is stored for billing purpose.

4. Lee teaches about the potential for the internet and the problem cause when one user is allowed to access more than one terminal (Col 1, line 60- Col 2, line 20). Lee teaches the solution of using terminal use information (Col 2, line 60-Col 3, line 15). It would have been obvious at the time of the invention for some one of ordinary skill to improve on the billing process of Dedrick by using Lee invention which provide the means for better transaction recording in a growing complex technology like the internet.

5. Regarding claim 14, Dedrick combined with Lee, teaches about a terminal unit comprising: use record information writing means for writing use record information used by the user (Col 5, lines 50-65); storing means detachable provided in said terminal unit for storing profile information of said user so that when the user uses a terminal unit, the terminal unit accesses the user profile information from the storing means to obtain information peculiar to the particular user using the terminal unit (Dedrick Col 6, lines 5-15); transmitting means "session manager" for transmitting said

use record information "personal profile" accumulated in storing means "personal profile database 27" to profile information generating means remote from the terminal unit for every prescribed timing (Dedrick Col 5, lines 20-35) (Dedrick Col 6, lines 5-15) (Dedrick Col 9, lines 25-35); profile information writing means for receiving the profile information of said user based on said use record information which is transmitted from said profile information generating means and writing said received profile information in said storing means "personal profile database 30", wherein at least one of said use record information and said profile information includes identifying information for said terminal unit (Dedrick Col 9, lines 25-40); and (Transaction requires known the identities of the terminal and the server). selecting means for selecting provided information corresponding to said profile information written in said storing means from among provided information transmitted from prescribed information providing means (Dedrick Col 6, line 65- Col 7, line 10) (Dedrick Col 7, lines 55-65).

6. Regarding claim 18, Dedrick combined with Lee, teaches about a terminal unit comprising: use record information writing means for writing use record information used by a user in prescribed storing means detachably provided in said terminal unit for storing profile information of said user so that when the user uses a terminal unit, the terminal unit accesses the user profile information from the storing means to obtain information peculiar to the particular user using the terminal (Dedrick Col 5, lines 50-65) (Dedrick Col 6, lines 5-15). (Dedrick Col 5, lines 20-40) (Covered in claim 13); profile information writing means for writing profile information of said user in said storing means "personal profile database 27", wherein said profile information is generated by a

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profile information generating means "statistic compilation process 26" remote from the terminal unit on the basis of said use record information accumulated in said storing means, and wherein at least one of said use record information and said profile Information includes identifying information for said terminal unit (Dedrick Col 5, lines 20-40); and (The session manager has to know the identity of the terminal (IP source address) in order to setup a session between the terminal and server). selecting means for selecting provided information corresponding to said profile information written in said storing means from among provided information transmitted from prescribed information providing means (Dedrick Col 6, line 65- Col 7, line 10) (Dedrick Col 7, lines 55-65).

7. Regarding claim 21, Dedrick combined with Lee, teaches about an apparatus for providing information to a terminal unit remote from the apparatus, said apparatus comprising: profile Information generating means for generating profile information of a prescribed user based on the use record information of said terminal unit of said user transmitted from said terminal unit, wherein at least one of said use record information and said profile information includes identifying information for the terminal unit (Dedrick Col 5, lines 20-40) (Dedrick Col 9, lines 25-35) (Covered in claim 13); (The session manager has to know the identity of the terminal (IP source address) in order to setup a session between the terminal and server). transmitting means for transmitting said generated profile information to the terminal unit (Dedrick Col 5, lines 20-40); and storing means detachably provided in said the terminal unit for accumulating said use record information and said profile information so that when the user uses a terminal

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unit, the terminal unit accesses the user profile information from the storing means to obtain information peculiar to the particular user using the terminal (Dedrick Col 5, lines 50-65) (Dedrick Col 6, lines 5-15). (Dedrick Col 5, lines 20-40).

8. Regarding claim 23, Dedrick combined with Lee, teaches about an apparatus for providing information to a terminal unit remote from the apparatus, said apparatus comprising (Fig 1): profile information generating means for generating the profile information of a prescribed user base on use record information of said terminal unit of said user transmitted from said terminal unit wherein at least one of said use record information and said profile information includes identifying information for said terminal unit (Dedrick Col 5, lines 20-40) (Covered in claim 13); and (The session manager has to know the identity of the terminal (e.g. IP source address) in order to setup a session between the terminal and server). storing means for storing said profile information thus generated, wherein said storing means is a storage medium detachably provided in said terminal unit so that when the user uses a terminal unit, the terminal unit accesses the user profile information from the storing means to obtain information peculiar to the particular user using the terminal (Dedrick Col 5, lines 50-65) (Dedrick Col 6, lines 5-15). (Dedrick Col 5, lines 20-40) (Dedrick Col 5, lines 20-40) (Dedrick Col 6, lines 5-15).

9. Regarding claim 25, Dedrick combined with Lee, teaches about an apparatus for providing Information according to claim 23 further comprising: selecting means for selecting information supplied to said user base on the profile Information stored in said storing means (Dedrick Col 6, line 65- Col 7, line 10) (Dedrick Col 7, lines 55-65).

10. Regarding claim 27, Dedrick combined with Lee, teaches about a user information processing system comprising: a terminal unit adapted to accumulate terminal use record Information "client activity" upon use of the terminal unit by a user (Dedrick Col 5, lines 20-40); a storage medium detachably provided in said terminal unit so that when the user uses a terminal unit, the terminal unit accesses the user profile information from the storing means to obtain information peculiar to the particular user using the terminal (Dedrick Col 5, lines 50-65) (Dedrick Col 6, lines 5-15). (Dedrick Col 5, lines 20-40) a server adapted to generate profile information of the user "personal profile" on the basis of the terminal use record information accumulated by the terminal unit, wherein said terminal unit is adapted to accumulate the profile information generated by said server, and wherein at least one of said use record information and said profile information includes identifying Information for said terminal unit (Dedrick Col 5, lines 20-40).

11. Regarding claim 38, the prior art of record teaches the method and system wherein the apparatus is configured for providing information to a plurality of terminal units remote from the apparatus (see Dedrick, column 5, line 20 through column 6, line 3).

12. Regarding claims 34-41, the prior art of record teaches the method and system further comprising a plurality of terminal units adapted to accumulate terminal use record information when used by the user (see Dedrick, column 5, line 20 through column 6, line 3).



13. Regarding claim 42, Dedrick disclosed wherein the profile analysis processing part receiving said use record information and producing said original profile information based on said use record information includes specific information relating to user preference (see column 5, lines 50-59).

14. Claims 28-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick (U.S. Pat. No. 5,717,923), in view of Lee et al. (U.S. Pat. No. 6,751,459), hereinafter referred to as Lee, in further view of what was well known at the time of invention.

15. Dedrick disclosed the method and system substantially as detailed above, with the intention of monitoring and tracking a user's activity on a network (see column 5, lines 34-49). The system was concerned with storing personal data for each user (see column 5, lines 50-59). Similarly, Lee disclosed monitoring a user's activity pattern, including the location of the user, and storing such information in a user profile (see column 18, lines 6-41).

16. While the prior art discloses various types of data used for tracking a user, the prior art references do not specifically teach using GPS data as claimed.

17. Examiner takes Official Notice (see MPEP § 2144.03) that the use of GPS data in a computer networking environment was well known in the art at the time the invention was made.

18. It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Dedrick and Lee to provide a system for

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monitoring and storing information about a user's activity, the information including GPS data as claimed. Both Dedrick and Lee were concerned with providing information on a user's activity patterns, and as in Lee, specifically the location of a user. It was well known at the time of invention that GPS data could be used to track the location of a user. Accordingly, one of ordinary skill in the art would have been motivated to consider incorporating the use of GPS data in the prior art combination in order to improve the tracking system suggested and provided a more accurate and detailed set of information about a user.

### ***Response to Arguments***

19. Applicant's arguments filed 06/27/07 have been fully considered but they are not persuasive.

20. Regarding the rejection under 35 U.S.C. 103(a) under Dedrick in view of Lee, Applicant first asserts that the prior art references do not teach a detachable device. As stated in the Advisory Action, Examiner notes that Applicant has provided to specific argument regarding this point. Regardless, Examiner notes that a "detachable device" is not recited in any of independent claims 14, 18, 21, 23, 27, 35, 37, 39, or 41. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a detachable device) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Apart from this, Examiner assumes from the claim language that the “detachable device” as argued corresponds to the claimed “storing means detachably provided in said terminal unit”. As such, Examiner submits that such a detachable storage means for storing profile information as claimed is clearly taught by Dedrick, which provided a removable storage device/card to store a consumer profile (see column 6, lines 4-32).

21. Regarding claim 13, Applicant asserts that the prior art does not teach “a terminal unit for use by a user adapted for accumulating terminal use record information upon use of said terminal unit by said user and original profile information of said user generated on the basis of said terminal user record information”. Applicant argues that Dedrick characterizes the servers rather than the terminal employed by the user, and is thus distinct from the claimed invention. However, Examiner submits that Dedrick clearly disclosed a client terminal for monitoring the usage by a user and storing such information into a profile (see column 5, lines 34-49). Applicant further asserts that Dedrick does not teach comparing the collected information with the original profile, but instead with other information through a “content adapter”. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a step of comparing collected information with an original profile) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Regardless, Examiner submits that Dedrick reads on this broad concept as collected information was updated within the personal profile database (see column 5,

line 60 through column 6, line 3; column 6, lines 34-52). Applicant even acknowledges in the remarks that Dedrick teaches "The client system also includes a content adapter which compares electronic information received by the client system to the consumer information in the personal profile database".

22. Regarding claims 14 and 18, Applicant asserts that the prior art does not teach the limitation reciting "selecting means selects said provided information on the basis of said new profile information written in said storing means". Applicant argues that "Dedrick teaches only to use the entire profile information in the database to select information provided to the user, not the differential use of 'new' profile information". In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., differential use of 'new' profile information) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The limitation argued broadly requires only that the selecting means selects information on the basis of stored new profile information, but does not specify the result of such selection, any particulars on how such selection should be made, or what the claimed "basis" specifically requires. In other words, the selection means serves merely to "select" or "retrieve" newly stored profile data as currently claimed. Dedrick reads on this broad concept. Clearly, updated or "new" profile information was taught by Dedrick ("Personal profile database 27 is updated with user profile information based on the activity monitored by client activity monitor", see

column 5, lines 60-62), which was then "selected" to be used for adapting received content ("The content adapter 25 customizes electronic content to the individual end user based on the user profile data contained in the personal profile database", see column 6, lines 34-36).

### ***Conclusion***

The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03. However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)."

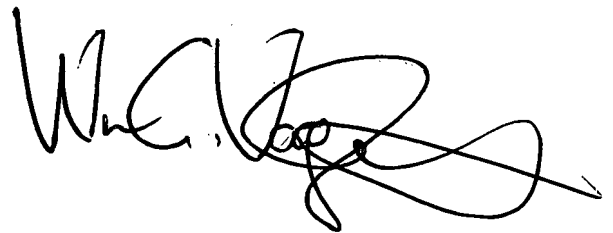
Specifically, *In re Boon*, 169 USPQ 231, 234 states "as we held in *Ahlert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R. Maniwang whose telephone number is (571) 272-3928. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William C. Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JM

A handwritten signature in black ink, appearing to read "W.C. Vaughn", with a large, stylized flourish extending from the end of the signature.